



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/674,653

09/30/2003

Marc E. Feinberg

ETH5092 [13926]

4786

25570

7590

02/13/2009

ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.

Intellectual Property Department

P.O. Box 10064

MCLEAN, VA 22102-8064

EXAMINER

RYCKMAN, MELISSA K

ART UNIT

PAPER NUMBER

3773

NOTIFICATION DATE

DELIVERY MODE

02/13/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lgallaugh@rmsclaw.com

dbeltran@rmsclaw.com

bdiaz@rmsclaw.com

|                              |                                      |                                          |  |
|------------------------------|--------------------------------------|------------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/674,653 | <b>Applicant(s)</b><br>FEINBERG, MARC E. |  |
|                              | <b>Examiner</b><br>MELISSA RYCKMAN   | <b>Art Unit</b><br>3773                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-6,8,14,21,22 and 27-50 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,14,21,22,27-37,43-45,49 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,6,8,38-42,46-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

Applicant's arguments, filed 9/17/08, have been fully considered and are persuasive. The finality of the office action dated 3/17/08 has been withdrawn.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the drawings must show the distal end of the elongate arm having a ball, and the adhesive pad having a socket must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

Art Unit: 3773

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 38 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed invention does not have the arms with a ball, and the adhesive pad with a socket.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 38 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the ball on the adhesive pad rotating in the socket, does not reasonably provide enablement for the pad rotating about the ball (both the pad and the ball rotate together, they are fixed together). The specification

Art Unit: 3773

does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, 8, 38-42, 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (US 6394951), and further in view of Coffey (U.S. Patent No. 2,003,629).

Regarding Claim 8, Taylor teaches a tissue approximation device comprising two elongate arms (3), an attachment means (144) to secure the elongate arms to each other at one or more locations, adhesive pads (4, Column 14, proximate lines 1-37) movably connected (18, 19) on at least a portion of the elongate arms to anchor the tissue approximation device to the tissue (fig. 321a), and a locking means (181) to lock the elongate arms in place relative to each other, wherein (i) the adhesive pads are spaced apart from the one or more locations of the attachment means (144) in the direction of the elongate arms, and (ii) the tissue approximation device has an open (fig. 31b) and a closed position (fig. 31a), and when in the closed position, the adhesive pads are parallel and non-contiguous to each other (fig. 31a).

Art Unit: 3773

Taylor teaches the second surface coupled to the distal end of each of the elongate arms by a ball and socket connector (18 and 19, Fig. 2), wherein the second surface has one of a socket and a ball that communicates with the other one of a ball and a socket on the distal end of each of the elongate arms.

Taylor does not teach the first and second sockets being having a rotatable connection, however Coffey teaches a rotatable connection between the elongate arms and the pad, and the adhesive pad is rotatable around the ball about at least two axes (slight rotation is possible along two axes). It would have been obvious to one of ordinary skill in the art to use the rotatable connection of Coffey with the device of Taylor as this allows smooth action and aids in use of the jaws (page 1, ll. 47-55, page 2, col. 1, ll. 1-3).

Regarding Claim 5, Taylor teaches the tissue approximation device of claim 1, wherein the elongate arms (3) form a pair of forceps, the attachment means (144) is a yoke on the forceps, and the locking means (151) is a ratchet mechanism on the forceps.

Regarding Claim 6, Taylor teaches the tissue approximation device of claim 5, wherein the distance between the elongate arms is adjustable by means of a ratchet mechanism (151).

Regarding Claim 38, Taylor teaches a tissue approximation device capable of application to a skin surface adjacent to a wound comprising: a pair of arms (3), each arm having a longitudinal axis and opposed ends, wherein one end includes a handle (fig. 31a) and the other end includes a tong (1) with a connector (19); and an

Art Unit: 3773

attachment mechanism coupled to each arm (144) such that the distance between each tong is selectively variable; an adhesive pad (4) removably coupled to the connector of each tong (18) wherein each adhesive pad has an adhesive surface (4) that extends in a plane generally parallel to the longitudinal axis of the respective tong (fig. 2), the adhesive surface having a high shear resistance, and wherein the connectors support the adhesive pads to be positionable in a common plane on opposed sides of a wound; and a locking mechanism (151) coupled to each arm to selectively lock the pair of arms in a fixed position relative to each other,

Taylor does not teach the first and second sockets being having a rotatable connection, however Coffey teaches a rotatable connection between the elongate arms and the pad, and the adhesive pad is rotatable around the ball about at least two axes (slight rotation is possible along two axes). It would have been obvious to one of ordinary skill in the art to use the rotatable connection of Coffey with the device of Taylor as this allows smooth action and aids in use of the jaws (page 1, ll. 47-55, page 2, col. 1, ll. 1-3).

Regarding Claim 39, Taylor teaches the arms are connected in a scissors configuration (fig. 31a)

Regarding Claim 40, Taylor teaches the adhesive pad (4) includes serrations.

Regarding Claim 41, Taylor teaches the locking mechanism (151) includes a ratchet.

Regarding Claim 42, Taylor teaches the arms (3) are made of resilient material (Column 12, proximate lines 50-60, it is noted that the present application only

Art Unit: 3773

describes that the arms may be made of either plastic or stainless steel, as taught by Taylor).

Regarding Claim 46, Taylor teaches the second surface has the socket (19) and the distal end has the ball (18, Fig. 2).

Regarding Claim 47, Taylor teaches the second surface has the ball (18) and the distal end has the socket (18, Fig. 2).

Regarding Claim 48, Taylor teaches the second surface and the distal end of the elongate arm connect in a snap fit manner (Fig. 2).

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA RYCKMAN whose telephone number is (571)272-9969. The examiner can normally be reached on Monday thru Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571)-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MKR

/Melissa Ryckman/  
Examiner, Art Unit 3773

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773